

### REMARKS

Claims 89, 91-100 are pending in this application. Claims 1-88 and 90 are canceled. Claims 89, 92, 95 and 98 are amended. No new matter is believed to have been added by the amendments.

In view of the above, Applicants respectfully submit that the claims are now in condition for allowance, and indication of such from the Office is respectfully requested. With respect to all amendments, Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any objection and/or rejection made by the Office. Applicants expressly reserve the right to pursue prosecution of any presently excluded claimed subject matter or embodiments in one or more future or pending continuation and/or divisional applications.

### Priority

The Examiner alleges that the provisional application upon which priority is claimed fails to provide adequate support under 35 U.S.C. 112 for claims 89 and 91-100, specifically, that allegedly there is no literal support in the applications wherein a suppressible termination codon is between or adjacent to the first and second genes. Applicants respectfully traverse.

Support for the pending claims can be found at least in the specification of the provisional application filed April 10, 1991 at, *inter alia*, page 20, lines 15-21; page 21, lines 19-22; and page 21, lines 32-36. Therefore, the pending claims are entitled to a priority at least as early as April 10, 1991. The Office's acknowledgment of such is respectfully requested.

### Rejection Under 35 U.S.C. § 102(e)

Claims 89, 91, 93 and 94 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Huse (US Pat. No. 5,770,434).

Solely in the interest of expediting prosecution, Applicants have amended claim 89. Amended claim 89 is directed to a gene fusion comprising a first gene encoding a first polypeptide, a second gene encoding *a portion of* a phage coat protein, and a suppressible termination codon between or adjacent to the first and second genes. (*italics added.*) The cited reference does not teach the invention of claim 89.

In view of the above, withdrawal of the instant rejection is respectfully requested.

Rejection Under 35 U.S.C. § 103(a) (cited references)

Claims 92, 95-100 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Huse (U.S. Pat. No. 5,770,434) as applied to claim 89-91, 93 and 94, in view of Ladner et al. (US Pat. No. 5,223,409).

As discussed above, claim 89, from which claim 92 depends, has been amended, thus rendering the rejection over Huse moot.

Solely in the interest of expediting prosecution, Applicants have amended claims 95 and 98. Amended claim 95 is directed to a gene fusion comprising a first gene encoding a first polypeptide, a second gene encoding *a portion of* a filamentous bacteriophage coat protein III, and a suppressible termination codon selected from the group consisting of UAG, UAA and UGA between the first and second genes. (italics added.) Amended claim 98 is directed to a gene fusion comprising a first gene encoding an antibody or a fragment thereof, a second gene encoding a portion of a filamentous bacteriophage coat protein III, and a suppressible termination codon selected from the group consisting of UAG, UAA and UGA between the first and second genes. (italics added.) As discussed above, Huse does not teach all the limitations of the claimed invention, and Ladner et al. does not cure the deficiency.

In view of the above, withdrawal of the instant rejection is respectfully requested.

Obviousness-type double patenting rejection

Claims 89 and 91-100 are rejected for obviousness-type double patenting as allegedly being unpatentable over claims 1, 6, 7 and 14 of U.S. Pat. No. 6,040,136. Claims 89 and 91-100 are rejected for obviousness-type double patenting as allegedly being unpatentable over claims 32-35 of U.S. Pat. No. 5,750,373.

Without acquiescing to the instant rejection, Applicants will execute a terminal disclaimer upon an indication of allowable subject matter in order to expedite allowance of the instant case.

**Form 1449 and Information Disclosure Statement**

Applicants note that Form PTO-1449 (8 sheets, listing references 67-238), hand-delivered to the Office on April 4, 2003, has not been initialed by the Examiner. A copy of the initialed form is respectfully requested from the Examiner.

**CONCLUSION**

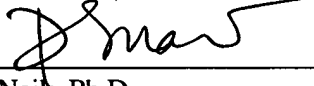
Applicants believe that this application is now in condition for immediate allowance and respectfully request that any remaining rejection be withdrawn and this case passed to issue. No new matter has been introduced, and entry of these amendments is respectfully requested. Reconsideration and further examination of the claims is respectfully requested.

The Examiner is invited to contact the undersigned at (650) 225-5530 in order to expedite the resolution of any remaining issues.

Respectfully submitted,  
GENENTECH, INC.

Date: 12/17/03

By: \_\_\_\_\_

  
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